

REMARKS

Before arguing substance, a synopsis of the needlessly protracted prosecution of this case is in order.

The above-referenced application was originally filed on November 16, 2001, with claims 1-25. In response to a restriction requirement dated March 3, 2003, applicants elected claims 1-10 for further prosecution. In a first substantive office action dated March 21, 2003, the Examiner first cited Hurh, U.S. Patent No. 4,998,656 as the primary reference for rejecting each of the pending claims, both as anticipating and obviating. In response to that office action, applicants filed an amendment on July 21, 2003 specifying the surface from which the retention walls of the pending application extend, thus differentiating the claims over the Hurh reference. In response, the Examiner issued a final office action, removing his anticipation rejection, but maintaining his rejection arguing that the amended claims would have been obvious in light of Hurh in combination with "Official Notice." In a response to that final office action, the claims were further amended to specify that the film dispenser further included a brace extending from the retention walls to thus maintain the angle with which the retention walls extend into the interior of the container. These amendments were made in no small part due to the wording of the final office action wherein the Examiner suggested such amendments would allow the claims to overcome the Hurh reference. Surprisingly, however, the Examiner then issued an Advisory Action stating that the claim amendments he had himself suggested as being sufficient to overcome the art would require further searching. In the interest of furthering the application, applicants filed a Request for Continued Examination asking that the amendment previously submitted be fully considered. Once forced to do so, the Examiner in fact did review the amendment but changed tactics not allowing the claims, but rather citing a new reference known as Shiffler. The Shiffler patent, as should have been noticed by the Examiner, was however not appropriate prior art in that it was owned by the same inventive entity as the pending application. In response to that office action, the applicants therefore filed a response not amending the claims, but pointing out the inability of the Examiner to cite the Shiffler reference under Section 103(c) as it did not qualify as prior art under any

section of 35 U.S.C. §102. The Examiner immediately agreed, but now applicants find themselves in the unnecessary position of again being rejected based on the previously cited Hurh reference, but now with the Shiffler reference removed and a new reference, Feinberg, U.S. Patent No. 2,330,117, being combined with the Hurh reference, again in combination with an inordinate use of "Official Notice" to reject the claims. Even more stunningly, the action has been issued as a final office action, even though no amendments were made in the previous response, and it was the Examiner's own mistake in inappropriately citing the Shiffler reference which even delayed prosecution as far as it has progressed. However, the applicants still maintain that there is patentable subject matter with respect to this application, and is again filing a response to provide the Examiner with an additional opportunity to allow the claims. Moreover, as the finality of the most outstanding office action is misplaced, applicants are requesting that the finality be removed such that this submission can be fully considered and thus avoid the needless expense of the applicant paying for yet another Request for Continued Examination. In the event that this amendment either does not result in the Notice of Allowance or issuance of another non-final office action, applicants are concurrently filing herewith a Notice of Appeal to bring this matter to the Board of Patent Appeals and Interferences, and thus bring closure to an already needlessly protracted and expensive prosecution.

INAPPLICABILITY OF FINAL REJECTION

In the very wording of the Manual of Patent Examining Procedure, it is stated that:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicants amendment of the claims, nor based on information submitted in the Information Disclosure Statement filed during the period set forth in 37 C.F.R. §1.97(c), with the fee set in 37 C.F.R. §1.117(p)."

As neither of these conditions apply, the finality of the previously issued and outstanding office action is misplaced and should be withdrawn. More specifically, as stated above, in response to the first action issued April 23, 2004, applicants filed a response without amending the claims. In addition, no information

disclosure statements were filed in that time period. As a result, the MPEP, specifically at §706.07(a) and quoted above, dictates that the finality of the office action was inappropriate and must therefore be withdrawn.

PRIOR ART REJECTIONS

Claims 1 and 4-10 have been rejected as obvious over Hurh in view of Official Notice. However, based on the amendments made to the claims, the very same amendments as suggested by the Examiner in the previous office action, applicants respectfully submit that the obviousness rejections thereof should be withdrawn.

Claim 1 specifies, *inter alia*, a wound film dispenser having a base, a lid, retention walls, and a brace extending from each retention wall, wherein the brace includes a tapered side edge which extends from a fold line where the brace meets the retention wall at the same angle at which the retention wall extends into the interior of the dispenser oblique to all other sides. Clearly this element is not disclosed or suggested by the Hurh reference, nor can such a limitation be viewed as sufficiently old and well-known in the art as to be covered by Official Notice. Hurh includes a brace 26 which extends from an end of retention wall 28. Based on the length of the brace 26, it is able to cause the retention wall 28 to extend angularly into the interior of the carton. However, the brace 26 includes no tapered side edge which corresponds to the angle at which the retention wall extends into the carton. Moreover, as with many of the items previously and conveniently disregarded by the Examiner by way of Official Notice, such a limitation cannot be dismissed under the provisions of the Official Notice provisions of the MPEP. As stated therein:

"In limited circumstances, it is appropriate for an Examiner to take Official Notice of facts not in the record or to rely on 'common knowledge' in making a rejection, however, such rejections should be judiciously applied." MPEP 2144.03.

That same section of the MPEP goes on to state that:

"While Official Notice may be relied on, the circumstances should be rare when an application is under final rejection or action under 37 C.F.R. §1.113. Official notice unsupported by documentary evidence should only be taken by the Examiner where

the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-know."

Here, while Hurh does establish that the use of braces are well-known, it does not establish that braces of the type disclose and now specifically claimed by the pending application are well-known. Accordingly, Hurh in combination with Official Notice fails to disclose or suggest all claim elements and thus do not form a sufficient basis for an obviousness rejection of the pending claims.¹

Similarly, claims 1, 4, 5, 7-10 have been rejected as obvious over Feinberg again in view of Official Notice. However, as Feinberg as admitted by the Examiner fails to disclose a brace at all, it adds nothing to the obviousness equation. Accordingly, Feinberg in combination with Official Notice fails to obviate the pending claims as well.

In light of the foregoing and the Examiner's suggestion of additional claim limitations which have now been incorporated to the pending claims, applicants respectfully request the allowance of claims 1 and 4-10. Applicants further submit that should such claims result in a notice of allowance, that the finality of outstanding action should be withdrawn, and that a subsequent action should be issued. Should the Examiner have any questions, he is respectfully invited to telephone the undersigned.

Dated: October 14, 2004

Respectfully submitted,

By 

Brent E. Matthias

Registration No.: 41,974

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant

¹ "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2143.